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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Kenichiro Matsuura

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09/02/2005

EXAMINER

PRIETO, BEATRIZ

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ART UNIT

PAPER NUMBER

2142

DATE MAILED: 09/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/909,042

Applicant(s)

MATSUURA ET AL.

Examiner

Prieto B.

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2005.  
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 54-64 and 66-98 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) \_\_\_\_\_ is/are rejected.  
7) ☐ Claim(s) 54-64 and 66-98 is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 7/19/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 07/28/05.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

***DETAILED ACTION***

1. This communication is in response to Amendment after-final filed 08/11/05, claims 54-64, 66-98 remain pending.
2. Acknowledgment is made to claim priority under 35 U.S.C. §119 for the benefit of the earlier filing date with respect to Japanese Patent Application No. 2000-222814 filed July 24, 2000. A certified copy of the application has been received and placed in file.
3. Interference search was conducted, which results raised substantial new question of patentability of a claim(s) as amended. Finality of previous office action mailed 6/13/05 is hereby withdrawn. All amendments filed after the final rejection have been entered.
4. Claims terminology has been applied the broadest reasonable interpretation in light of the specification (see MPEP 2111/2106). In this case, the claimed terms are to be given their ordinary and customary meaning by clearly setting forth a definition of the term unless the applicant provides an explicit definition for a term, in which case that definition will control interpretation of the term as it is used in the claim. Specifically, the claimed term(s)/clause(s): (i) "abstract" has been interpreted as information that has been summarized or condense; (ii) "not presentable" at the target terminal has been interpreted as information not being able to be shown, viewed or rendered; (iii) "the forwarding terminal" broadly, speaking is a storage device (e.g. a server) associated with respective conversion module, the server accessible by the target terminal, i.e. recipient (p. 12, line 25 to p. 13, line 25, and p. 16, line 6-27).

***Claim Rejection under 35 U.S.C. 103***

5. Quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action may be found in previous office action.
6. Claims 54, 57, 60, 64-66, 69, 72, and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 6,092,114) SHAFFER et. al. (Shaffer hereafter) in view of Kudrolli et. al. (US 6,279,018) (Kudrolli hereafter).

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Regarding claim 55, Shaffer teach an apparatus comprising:

reception means (12) for receiving transmission information addressed to a user (col 3/lines 63-col 4/line 4, step 40 of Fig. 2, col 6/lines 6-18 and col 8/lines 35-41) at a target terminal (col 5/lines 51-55);

determination means (12) for determining whether the transmission information is presentable at the target terminal or conversion is required (step 48 of Fig. 2, col 6/lines 54-65, col 1/lines 55-col 2/line 3);

conversion means (12) for converting the transmission information to be presentable at the forwarding terminal (step 52 of Fig. 2, col 6/line 66-col 7/line 6); and

control means (12) for controlling to send, i.e. transmitting the converted transmission information to the forwarding terminal (step 52 and 48 of Fig. 2);

deciding a server to forward transmission information when transmission information is not presentable at the target terminal (assigning a server for conversion thereon, abstract, col 2/lines 30-45, step 50 deciding where the conversion can be made, col 7/lines 2-3) and

forwarding said transmission information to said decided server (col 3/lines 24-28, sending request for conversion to decided server col 7/lines 20-23) information to be presentable from the forwarding terminal (col 3/lines 58-col 4/line 1, 10-14); however Shaffer does not teach creating a summary, condense form (i.e. abstract) from the transmission information in accordance to the number of characters presentable at a terminal.

Kudrolli teaches the abstraction of a text messages based on control parameters that allow the deletion (cut) of character strings (vowels) from words (col 2/lines 20-36);

deleting/truncating character strings including one or more alphabets characters, words or text (col 4/lines 18-19, 25, col 7/lines 56-col 8/line 38); truncating until a desired output length is reached (col 20/lines 43-53);

abbreviating text to a predetermined length (col 5/lines 59-col 6/line 6, screen sizes (col 9/lines 53-67) based on the number of characters presentable on the screen (OptL) (col 53/line 30-55, 65-67, number of characters presentable and file to be abbreviated see col 18/lines 42-50).

It would have been obvious at the time the invention was made given the suggestion of Shaffer for sending information from a sending client device or from a server to another server (e.g. email/ISP servers) that supports a computer or client device at which the receiving party accesses/downloads send message, performing conversion on the server(s)/client(s), where the clients devices may be any device including wireless device, the teaching of Kudrolli relates to text abbreviation methods to cope with

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display space constraints, typical in wireless device would be readily apparent. Given the teachings of Schaffer for storing information indicating of the presentation abilities identifying all of the access capabilities of the client devices that are used to access information presentable at the forwarding terminal. It would be readily apparent to one ordinary skill to store the number of characters presentable at the forwarding terminal comprising local/remote servers discussed by Schaffer or any equivalent storage device suggested thereon. One ordinary skilled would be motivated to accommodate information by abbreviation in the available display space associated with the target terminal, thus overcome the display unit constraints, noted by Kudrolli (col 4/lines 1-4) in Shaffer's system suitable for wireless devices.

Regarding claim 54, a database which stores data indicative of presentation ability of a forwarding terminal, in the form of a data structure "table" (Schaffer: col 6/lines 31-53).

Regarding claim 56, this claim comprises features/limitations substantially the same as those discussed on claim 55, further limitations include deleting/truncating character strings including one or more alphabets characters, words or text (col 4/lines 18-19, 25, col 7/lines 56-col 8/line 38); truncating until a desired output length is reached (col 20/lines 43-53) as applied rationale on claim 55.

Regarding claim 57, although the above mentioned prior disclosed the notification of undelivered transmission information, it does not teach notification means for notifying the target terminal of a notification representing that the transmission information is forwarded to the forwarding terminal.

*Official Notice (see MPEP § 2144.03 Reliance on "Well Known" Prior Art)* is taken that message arrival notification, e.g. email was old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to generate a notification message of received message, e.g. appending uniform resource locator (URL) in notification and transmitting notification message to intended recipient. Specifically, wherein on arrival of a new message, it is stored in a server node, e.g. at a specific location in a message centre in the server node and the node embeds or appends a uniform resource locator (URL) in or to the E-mail notification message, which is to notify the recipient that a new electronic message has arrived and to identify the precise address or location of the stored message. The notification is then transmitted to the intended recipient's mailbox. Motivation would be to enable web

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information accessible via URLs over a network such as the Internet, because URL embedded document enable user to via one document access another document, audio, video or other multi-media information via a single click. Supportive references provided below as pertinent prior art.

7. Claims 58 and 70-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer in view of Kudrolli in further view of US 5,881,233 TOYODA et. al. (Toyoda hereafter)

Regarding claim 58, however the above prior art does not explicitly teach the conversion into facsimile data;

Toyoda teaches means (5) to convert mail text data to a fax format (col 8/lines 3-10), image data in to fax format (col 1/lines 50-58), generating a cover sheet (col 3/lines 43-48) and generating cover page data representing an address of a data destination, and said providing means attaches cover page data to the facsimile data obtained (Toyoda: col 3/lines 43-48).

It would have been obvious to one ordinary skilled in the art at the time the invention was made to include the teachings of Toyoda given the suggestions of Schaffer directed to message delivery systems and resource capabilities of devices in a business corporate environment, it would have been obvious to one ordinary skilled in the art to include fax machines as resource device present in this environment. Motivation to convert email and transmit to a fax would be redirect large document to fax machine diverting them from portable (low storage or displayable resource) terminals.

Regarding claim 59, comprises cover page generation means for generating cover page data representing an address of a data destination, and said providing means attaches cover page data to the facsimile data obtained (Toyoda: col 3/lines 43-48)

Regarding claim 60, although Schaffer suggests downloading transmission information from a web server including HTML documents, however it does not explicitly teach when destination is an apparatus web capable device the output data is accessible by a URL over the network.

*Official Notice (see MPEP § 2144.03 Reliance on "Well Known" Prior Art)* is taken that HTML document typically contain hyperlink having URLs embedded was old and well known in the Data Processing art. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to include web information accessible via URLs over a network such as the Internet, because

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URL embedded document enable user to via one document access another document, audio, video or other multi-media information via a single click.

8. Claims 61 and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer in view of Kudrolli in further view of US 6,629,130 MERTAMA et. al. (Mertama hereafter).

Regarding claim 61, Schaffer teaches designation conversion means, wherein said conversion means converts each of the parts so that each of the parts becomes appropriate for representation at the forwarding terminal, which convert the transmission information in a format suitable for display by the recipient destination terminal (col 2/lines 30-65, col 8/lines 35-69), including text messages having attachments of different formats (col 1/lines 15-19); further including

identifying divided data or parts contained in the transmission information and their associated format (col 9/lines 60-64) and conversion such divided data or parts such that each part is in a suitable format displayable by the destination terminal, i.e. integrating the respective data format-converted on the basis of the designation of said designation means (col 9/line 65-col 10/line 15); however Schaffer does not teach division means for dividing the data contained in the transmission information;

Mertama teach a system/method related to electronic messaging system, wherein electronic mail server (11) ("division means") divide the data contained in the transmission information (e.g. e-mail) into predefined structural parts, each part associated with a data type, e.g. mail text format (col 1/lines 15-55, col 6/lines 34-38, 41-56), where these different format parts require that the destination/receipt terminal has the capability to display them (col 1/lines 56-64) including portable terminals (col 3/lines 27-29).

It would have been obvious to one ordinary skilled in the art at the time the invention was made given to include Mertama's teachings for dividing predefined structural parts in transmission information and converting if need by the destination terminal. Motivation would be to leave the attachment of a text mail message for transmission to the destination upon determination step if attachment part found to be displayable at the destination terminal.

9. Claims 62-63 and 74-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer-Kudrolli in view of Mertama in further view of (US 5,859,967) Kaufeld et. al. (Kaufeld hereafter).

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Regarding claims 62-63, however the above-mentioned prior art does not explicitly teach billing the user for conversion services performed.

Kaufeld teaches converting an email ("transmission information") to a fax and transmitting the facsimile and charging for this service (col 5/lines 26-28); including charging for the format conversion service (col 11/lines 51-62).

It would have been obvious to one ordinary skilled in the art at the time the invention was made given the suggestions of Schaffer for conversion services being provide by service providers to subscriber, that billing procedures are typical in a provider-subscriber environment. Thereby, converting the transmission information based on a fee charged by converting processing would have been obvious. Motivation to combine these teachings would be given that Schaffer's system includes a plurality of client devices that may or may not have displaying limitations to implement a pay-as-you-use system, thereby accruing charges only when the conversion is performed.

Regarding claim 64, wherein the transmission information is an electronic mail (Schaffer: col 3/line 63-col 4/line 3).

Canceled claim 65

Regarding claim 66, this claim is substantially the same as claim 54 discussed above, same rationale of rejection is applicable.

Regarding claims 69-71, 72-76, this claim is substantially the same as claims 55-71, 60-64 same rationale of rejection is applicable.

Regarding claim 77, this claim is the computer readable medium storing a control program causing a computer to execute an information providing apparatus of claim 53 and method of claim 65, discussed above, same rationale of rejection is applicable.

Regarding claims 78-86 these apparatus claims are substantially the same as the apparatus claims 54, 57-64, respectively, same rationale of rejection is applicable.

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Regarding method claims 87-95 these method claims are substantially the same as the method claim 66, 57-64 respectively.

Regarding computer-readable medium claims 96-98, these are substantially the same as the apparatus claims 55-56, same rationale of rejection is applicable.

10. Applicant's claimed invention has been given full consideration. However, the prior art of record teaches features of the invention, specifically, converting received information addressed to a target terminal when determined that said information is not presentable at the target terminal, i.e. converting received information to a format suitable for presenting at the target terminal. Prior art further teaches forwarding received information to a server when determined that received information addressed to the target terminal is not presentable at the target terminal, for conversion thereon and retrieval by the target terminal. Prior art also teaches cutting the number of characters of received information or condensing said received information to a length suitable for presenting at the target terminal. Forwarding information for storing and/or converting to a server, e.g. Email server, ISP or a web server is disclosed by the prior art of record. Shaffer discloses as prior art email messages transmitted by a sending device are forwarded to a server for access by the recipient, specifically forward to a server for presenting the information in accordance to the recipient capabilities, where the message may be forward to a second server if need that will support the access by the recipient for downloading, further teaching as part as his invention that the conversion may be performed on either any of these server or the client as well on either the sending or receiving end.

***Citation of Pertinent Art:***

11. The following prior art made of record and not relied upon are considered pertinent to applicant's disclosure. Copies of Non-Patent Literature documents cited will be provided as set forth in MPEP§ 707.05(a):

WO 98/58332

Eriksson, M., et. al. teaches accessing and retrieving messages includes generating notification message of received message, appending uniform resource locator (URL) with security key and transmitting notification message to intended recipient. Specifically, wherein on arrival of a new message (102), it is

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stored in a server node, e.g. at a specific location in a message centre in the server node and the node embeds or appends a uniform resource locator (URL) in or to the E-mail notification message, which is to notify the recipient that a new electronic message has arrived and to identify the precise address or location of the stored message. The notification is then transmitted to the intended recipient's mailbox.

US 5,555,100

Bloomfield et. al. teaches notifying an intended recipient through a variety of notification methods of the existence of stored information received, such notification methods including this pager service notification, a voice notification to live or automatic recording devices, E-mail transmissions, etc.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prieto, B. whose telephone number is (571) 272-3902. The Examiner can normally be reached on Monday-Friday from 6:00 to 3:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, Andrew T. Caldwell can be reached at (571) 272-3868. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system, status information for published application may be obtained from either Private or Public PAIR, for unpublished application Private PAIR only (see <http://pair-direct.uspto.gov> or the Electronic Business Center at 866-217-9197 (toll-free).

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